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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/707,181

11/25/2003

Milton Rodriguez

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22891 7590 09/19/2008  
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EXAMINER

LIN, JAMES

ART UNIT

PAPER NUMBER

1792

MAIL DATE

DELIVERY MODE

09/19/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/707,181	RODRIGUEZ, MILTON	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jimmy Lin	1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 15-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-11 and 15-23 is/are rejected.
- 7) ☒ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/28/2008 has been entered.

### ***Claim Objections***

2. Claim 3 is objected to because of the following informalities: the recitation of "fluorescent" should be amended to "the fluorescent material" so that the claim will be consistent with independent claim 1. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 is inconsistent with independent claim 1. One of the plurality of paint layers of claim 2 can be considered as an "intermediary layer" as required by claim 1 since an intermediary layer is a layer that is in between other layers. Thus, it is indefinite as to whether or not claim 2 is limited to "without use of any intermediary layer" because one of the intermediate paint layers is an intermediary layer.

Claim 5 requires "the paint layers" while independent claim 1 requires "at least one paint layer". It is indefinite as to whether or not claim 5 includes the embodiment of having only one paint layer. For the purposes of this examination, the limitation will be interpreted to be at least inclusive of both.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 3, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gosselin et al. (U.S. Patent No. 5,885,677) in view of Torgersen et al. (U.S. Patent No. 4,303,701) and Liu et al. (U.S. Patent No. 2002/0114929).

Gosselin teaches a method of making a security label to be placed on an object (abstract). The object can be a painted metal surface (col. 5, lines 12-14; Examples 1-6). A UV fluorescent material is applied onto the paint layer and is allowed to diffuse into the surface. The material forms an identifier pattern such as a vehicle identification number (VIN) (col. 3, lines 10-37). Upon removal of the security label, there are no intermediary layers between the fluorescent material and the paint layer.

Gosselin does not teach that an excess amount of fluorescent material is removed from the paint layer with a solvent. Gosselin only generically teaches that the security label is removed after the fluorescent material has diffused into the paint layer (Examples 1-6). However, Torgersen teaches that it was well known to have applied fluorescent materials onto a surface to allow the material to impregnate the surface and to have removed the excess fluorescent material with a solvent (col. 1, lines 61-68; col. 3, lines 49-66). Because Torgersen teaches that such methods were operable in the art, it would have been obvious to one of ordinary skill in the art at the time of invention to have removed the excess fluorescent material of Gosselin with a solvent with a reasonable expectation of success. The selection of something based on its known suitability for its intended use has been held to support a prima facie case of obviousness. *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945).

Gosselin does not teach that fluorescent emission is visible at an acute angle to the object surface without use of an ultraviolet light, while being substantially invisible at an angle normal to the object surface. However, Liu teaches that fluorescent ID markers may

be visible directly (normal incidence viewing) or at an acute angle to the object surface without use of an ultraviolet light, while being substantially invisible at an angle normal to the object surface (Figs. 1-3). It would have been obvious to one of ordinary skill in the art at the time of invention to have used such selective transmission in the security identification pattern of Gosselin with a reasonable expectation of success. One would have been motivated to do so in order to have increased the security and verification of the object. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used such selective transmission to increase security and verification of article because Liu teaches that such selective transmission increases security and verification of article.

Claim 3: Gosselin suggests that the object and the fluorescent material are at room temperature during application. Also, Torgersen teaches that the object may be at ambient temperature when the fluorescent material is applied to it (col. 3, lines 37-38).

Claim 5: Gosselin suggests that the identifier pattern can be a VIN applied to a painted metal surface.

Claim 6: Gosselin teaches that the VINs are alphanumeric (Examples 2-6).

Gosselin does not explicitly teach that the VIN is applied at a selected unrevealed location. However, it is conventional to apply VINs in both known and unrevealed location of various auto parts in order to add security. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to have used the method of Gosselin to apply VINs in both revealed and unrevealed locations of a vehicle.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gosselin '677 in view of Torgersen '701 and Liu '929 as applied to claim 1 above, and further in view of Cleary (U.S. Patent No. 5,811,152, hereafter '152).

Gosselin does not teach that the fluorescent material is a liquid and that the solvent is non-aqueous. However, Cleary teaches that it was well known to use a fluorescent material soluble in a solvent system (col 2, lines 52-53), wherein the solvent can be a volatile solvent (col 4, line 40-41) to produce a unique formulation. Because Cleary teaches that such fluorescent compositions were operable, it would have been obvious to one of ordinary skill in the art at the

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time of invention to have used a liquid fluorescent material in an aqueous solvent with reasonable expectation of success.

8. Claims 7, 8, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gosselin '677 in view of Torgersen '701 and Liu '929 as applied to claim 1 above, and further in view of van Duynhoven (U.S. Patent No. 6,358,563).

Gosselin does not teach that the fluorescent material is a liquid and that the fluorescent material is applied to the paint layer by brush. Van Duynhoven teaches that luminescent paint can be applied by brush (col 2, lines 63-64) and stencil (col 3, line 8). Because van Duynhoven teaches that such methods were operable in the art, it would have been obvious to one of ordinary skill in the art at the time of invention to have used a brush and a stencil to apply the fluorescent material of Gosselin with a reasonable expectation of success.

9. Claims 9 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gosselin '677 in view of Torgersen '701, Liu '929, and van Duynhoven '563 as applied to claim 8 above, and further in view of Sims (U.S. Patent No. 2,438,828).

Gosselin teaches the use of a stencil (i.e., a barrier medium) and a release sheet (i.e., backing layer), but does not teach that the stencil and release sheet are made accordingly the limitations of claim 9. However, Sims teaches the stencil being created comprising the method of:

a) providing a stencil sheet 15 (Fig. 1) having an adhesive backing layer 23,23a attached to a release sheet 27 (col 2, lines 19-23),

b) cutting the alphanumeric identification 13,14 into the stencil sheet without cutting through the release sheet (i.e., mark with opening that mark portions of the surface) (col 1, line 47- col 2, line 19),

d) placing the stencil sheet with cut alphanumeric identification and adhesive backing layer onto a second adhesive layer 24 (col 2, lines 23-28),

c) removing the stencil sheet with cut alphanumeric identification and adhesive backing layer from the release sheet 27 (col 3, lines 10-12),

e) removing the stencil sheet and adhesive backing layer without the cut alphanumeric identification from the second adhesive layer 24 creating cut openings 21,22 on the stencil sheet (col 3, lines 16-22) and leaving the cut alphanumeric identification on the second adhesive layer (Fig. 5).

Because Sims teaches that such methods were operable for forming a stencil with a release layer, it would have been obvious to one of ordinary skill in the art at the time of invention to have used the methods of Sims to make the stencil of Gosselin with a reasonable expectation of success.

10. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gosselin '677 in view of Torgersen '701 and Liu '929 as applied to claim 1 above, and further in view of Small et al. (U.S. Patent No. 4,927,663).

Gosselin does not teach that the fluorescent material comprises a non aqueous-based ultraviolet ink. However, Small teaches that a non-aqueous ultraviolet (UV) ink can be used in color printing (col 3, lines 37-40). Because Small teaches that such compositions were operable in the art of applying UV ink, it would have been obvious to one of ordinary skill in the art at the time of invention to have used a non aqueous UV ink as the particular ink of Gosselin with a reasonable expectation of success.

11. Claims 6 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gosselin '677 in view of Torgersen '701 and Liu '929 as applied to claim 1 above, and further in view of Bromer (U.S. Patent No. 6,476,715) and Moon et al. (U.S. Publication No. 2004/0179267).

Gosselin does not explicitly teach putting the VIN in an unrevealed location and recording the VIN and unrevealed location in a searchable database. However, Bromer teaches that it was well known to have placed a VIN in a hidden location of a vehicle [0074], and Moon teaches that it was well known to have secret information of a vehicle's VIN to be placed in a searchable database (col. 9, lines 5-13). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to have placed the VIN of Gosselin in a hidden location of the vehicle and to have recorded the VIN and the secret location in a searchable

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database with a reasonable expectation of success because the combination of Bromer and Moon would have reasonably suggested such methods.

Claim 20: Gosselin indicate the fluorescent material may be applied directly to the unpainted metal surface (col 5, lines 12-14). Although it states that such dyes do not *readily* penetrate the unpainted metal surface, at least some degree of penetration must occur.

Claim 21: Gosselin teaches that the object can be a painted surface.

12. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gosselin '677 in view of Torgersen '701 and Liu '929 as applied to claim 1 above, and further in view of Marsek (U.S. Patent No. 5,104,711).

Gosselin does not teach that the paint is a urethane-based paint. Marsek teaches that urethane paint can be used to paint a vehicle (col 1, lines 21-22). Because Marsek teaches that such paints were operable for painting vehicles, it would have been obvious to one of ordinary skill in the art at the time of invention to have used a urethane-based paint on the vehicle surface of Gosselin with a reasonable expectation of success.

13. Claim 16 is rejected over Gosselin '677 in view of Torgersen '701, Liu '929, van Duynhoven '563 as applied to claim 15 above, and further in view of Marsek '711 for substantially the same reasons as discussed immediately above.

14. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gosselin '677 in view of Torgersen '701, Liu '929, van Duynhoven '563, and Sims '828 as applied to claim 17 above, and further in view of Marsek '711 for substantially the same reasons as discussed immediately above.

15. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gosselin '677 in view of Torgersen '701, Liu '929, Bromer '715, and Moon '267 as applied to claim 19 above, and further in view of Marsek '711 for substantially the same reasons as discussed immediately above.



16. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gosselin '677 in view of Torgersen '701, Liu '929, Bromer '715, and Moon '267 as applied to claim 19 above, and further in view of Rohrbaugh et al. (U.S. Publication No. 2002/0176982).

Gosselin does not teach that the vehicle surface comprises fiberglass and the identifier pattern is embedded in the fiberglass. Gosselin only teaches that the fluorescent material readily penetrates a variety of plastics and painted metal surface (col. 5, lines 12-14). However, Rohrbaugh teaches that it was well known to have used vehicle bodies can be made of fiberglass [0028]. Because Rohrbaugh teaches that such materials were operable in the art, it would have been obvious to one of ordinary skill in the art at the time of invention to have used fiberglass as the particular vehicle body material of Gosselin with a reasonable expectation of success. The fluorescent material of Gosselin will necessarily penetrate between the fibers of the fiberglass at least to some degree because fiberglass is a porous material.

### ***Double Patenting***

17. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

18. Claims 1-11 and 15-18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3-14, 24 of copending Application No. 10/707,183. Although the conflicting claims are not identical, they are not patentably distinct from each other because '183 does not explicitly require viewing the unique discrete identification at an acute angle. However, '183 does require that the paint layer is only visible at an acute angle and substantially invisible at a normal angle. Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention that was seeking to identify the object would have chosen to view the object at the acute angle from which the unique discrete identification was visible.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

19. Claims 19-22 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3-14, 24 of copending Application No. 10/707,183 in view of Bromer '715 and Moon '267. Although the conflicting claims are not identical, they are not patentably distinct from each other because '183 does not require applying the unique discrete identification to an unrevealed location and recording the unique discrete identification and the unrevealed location in a searchable database. However, such would have been obvious to one of ordinary skill in the art over Bromer and Moon for substantially the same reasons discussed above.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

20. Claim 23 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3-14, 24 of copending Application No. 10/707,183 in view of Bromer '715, Moon '267, and Rohrbaugh '982. Although the conflicting claims are not identical, they are not patentably distinct from each other because '183 does not require wherein the vehicle surface comprises fiberglass. However, such would have been obvious to one of ordinary skill in the art over Rohrbaugh for substantially the same reasons discussed above.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Response to Arguments***

21. Applicant's arguments filed 7/28/2008 have been fully considered but they are not persuasive.

Claims 1, 15, and 17:

Applicant argues that Liu requires the application over the colored portions of an intermediary color shifting polymeric film in order to view the fluorescent indicia at various angles. However, the term “intermediary layer” is being interpreted to be a layer being in between. The object of Gosselin does not have any layers between the fluorescent material and the surface on which it is coated and, thus, does not have any intermediary layers.

Claims 19-23:

Applicant argues that Jack does not disclose or suggest that both the unique discrete identification as well as the unrevealed location on the vehicle surface is recorded in the searchable database. However, the teachings of Bromer and Moon have been used to replace the Jack reference because they provide a clearer teaching of the claim. See above rejection for details.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy Lin whose telephone number is (571)272-8902. The examiner can normally be reached on Monday thru Friday 8AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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1792